

REMARKS

The Applicants have carefully reviewed the Final Office action mailed September 17, 2007 and thank Examiner Binda for his detailed review of the pending claims. In response to the Office action, Applicants have amended claims 1, 8, and 15. No new matter has been added. Accordingly, claims 1-22 remain pending in this application. At least for the reasons set forth below, Applicants respectfully traverse the foregoing rejections. Further, Applicants believe that there are also reasons other than those set forth below why the pending claims are patentable, and reserves the right to set forth those reasons, and to argue for the patentability of claims not explicitly addressed herein, in future papers.

Applicants respectfully request reconsideration of the present application in view of the above amendment and the following remarks.

Examiner's Response to Previous Amendment

In the Office action dated September 17, 2007, the Examiner stated that the amendment filed on August 28, 2007 is objected to because the changes to the specification are directed to numbered paragraphs, but the paragraphs in the specification are unnumbered. Applicants have referenced the published patent application that corresponds to the present application, U.S. Patent Pub. No. 2004/0017046, published on January 29, 2004 to refer to paragraph numbers in the specification. Therefore, because the published application includes paragraph reference numbers, withdrawal of the objection and entry of the amendments to the specification is therefore respectfully requested.

Objection to Drawings

The Examiner objected to the drawings because the include reference numeral 45 which is not mentioned in the specification. As discussed above, Applicants have referenced U.S. Patent Pub. No. 2004/0017046 for amendments to the specification to overcome the drawing objection. Entry of the amendment and withdrawal of the objection is therefore respectfully requested.

Objection to Specification

The Examiner objected to the specification for failing to provide antecedent basis for the “rubber” recited in claims 2, 9, 16 and 22. As discussed above, Applicants have referenced U.S. Patent Pub. No. 2004/0017046. Entry of the amendment and withdrawal of the objection is therefore respectfully requested.

Claim Rejections Under 35 U.S.C. §102

1. The Law

To anticipate a claim, the reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

2. Blee (U.S. 5,379,856)

Claims 1-3, 5, 8-10, 12, 15-17 and 19 were rejected under 35 U.S.C. 102(b) as being anticipated by Blee, (U.S. Patent No. 5,379,856).

Applicants notes that independent claims 1, 8 and 15 have been amended to require “an interconnecting shaft including a first circumference,” and “a body portion having a central inner cavity including a second circumference and an inner wall, said second circumference defined by said inner wall, said second circumference being smaller than said first circumference of said interconnecting shaft so as to provide an interference fit,” (emphasis added).

Blee does not teach all of the recitations found in claims 1, 8 and 15 and therefore cannot anticipate independent claims 1, 8 and 15. More specifically, Applicant specifically draws attention to column 2, lines 60-64 and FIG. 2 of Blee (reproduced below for the Examiner’s convenience) to demonstrate Blee teaches “[t]he deformable and compressible body 40 has a generally tubular configuration and has a cylindrical inner side surface 46 though which the rack extends.” Indeed,

Blee does not teach or suggest “an interconnecting shaft including a first circumference,” and “said second circumference defined by said inner wall, said second circumference being smaller than said first circumference of said interconnecting shaft so as to provide an interference fit.” Instead, Blee only teaches that the compressible body 40 has a cylindrical side surface 46 through which the rack 14 extends. Accordingly, Blee teaches away from Applicant’s claimed invention, as defined by independent claims 1, 8 and 15, and Blee does not teach every recitation of independent claims 1, 8 and 15, as required by *Verdegaal Bros.*

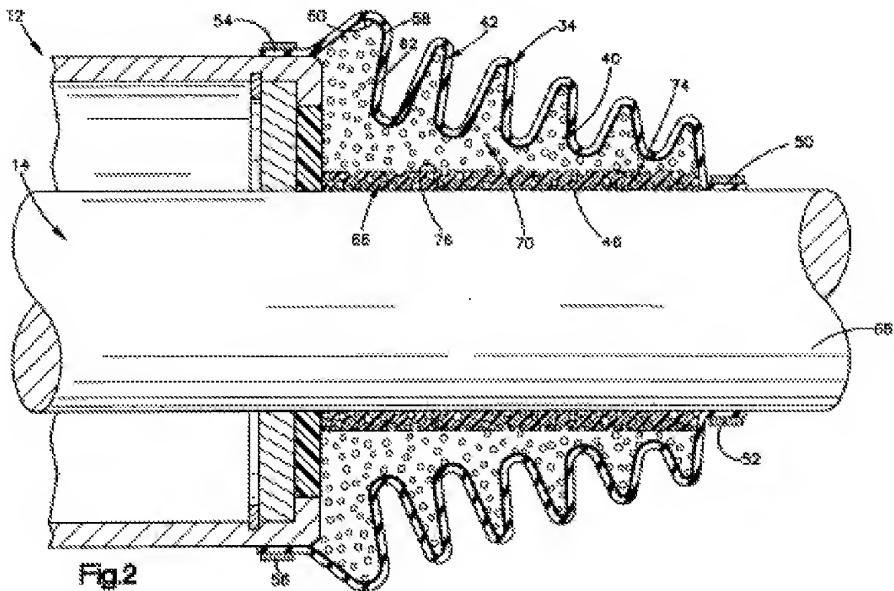


Fig 2 of Blee

Dependent claims 2-3, 5, 9-10, 12, 15-17 and 19 depend from patentable independent claims 1, 8 and 15 and include additional recitations that are separately patentable. Merely by way of example, dependent claim 2 recites “wherein said foam material is foam rubber.” Accordingly, withdrawal of the rejection is respectfully requested.

3. Avers (U.S. 4,500,151)

Claims 1-5 and 8-12 were rejected under 35 U.S.C. 102(b) as being anticipated by Ayers, (U.S. Patent No. 4,500,151).

Applicant notes that independent claims 1 and 8 all require “an interconnecting shaft including a first circumference,” and “a body portion having a central inner cavity including a second circumference and an inner wall, said second circumference defined by said inner wall, said second circumference being smaller than said first circumference of said interconnecting shaft so as to provide an interference fit,” (emphasis added).

Ayers does not teach all of the recitations found in claims 1 and 8 and therefore cannot anticipate independent claims 1 and 8. More specifically, Applicant specifically draws attention to column 3, lines 20-23 and FIG. 1 of Ayers (reproduced below for the Examiner’s convenience) to demonstrate Ayers teaches “[a] foam is injected through an opening 23 of boot 17 and into a space which surrounds the seal boot,” (emphasis added). Indeed, Ayers does not teach or suggest “an interconnecting shaft including a first circumference,” and “said second circumference defined by said inner wall, said second circumference being smaller than said first circumference of said interconnecting shaft so as to provide an interference fit.” Instead, Ayers only teaches there is foam surrounding the electrical cable 10 in FIG. 1. Thus, the outer boot 17 does not include a “second circumference smaller than said first circumference of said interconnecting shaft so as to provide an interference fit,” but rather “[a] foam [that is] injected through an opening 23 of the boot 17.” Accordingly, Ayers teaches away from Applicant’s claimed invention, as defined by independent claim 1, Ayers does not teach every recitation of independent claims 1 and 8, as required by *Verdegaal Bros.*

Application No. 09/755,798
Amdt. dated November 16, 2007
Reply to Office action of September 17, 2007

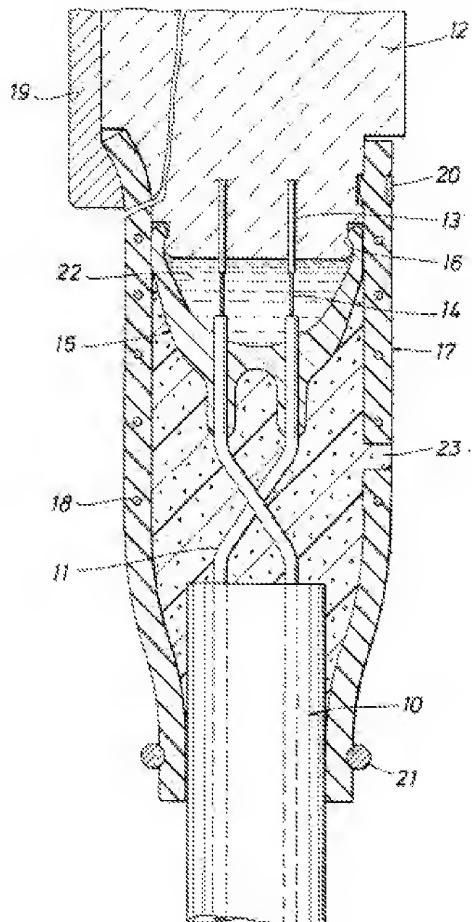


Fig. 1 of Ayers

Dependent claims 2-5 and 9-12 depend from patentable independent claims 1 and 8 and include additional recitations that are separately patentable. Accordingly, withdrawal of the rejection is respectfully requested.

4. Rabe (DE 296 17 276) (U.S. 6,152,641)

Claims 1-5, 8-12 and 15-19 were rejected under 35 U.S.C. 102(b) as being anticipated by Rabe, (DE 296 17 276, all references were taken from the English language equivalent U.S. Patent No. 6,152,641). Applicants respectfully traverse the rejections.

Applicants notes that independent claims 1, 8 and 15 all require “an interconnecting shaft including a first circumference,” and “a body portion having a central inner cavity including a second circumference and an inner wall, said second circumference defined by said inner wall, said second circumference being smaller than said first circumference of said interconnecting shaft so as to provide an interference fit,” (emphasis added).

Rabe does not teach all of the recitations found in claims 1, 8 and 15 and therefore cannot anticipate independent claims 1, 8 and 15. More specifically, Applicant specifically draws attention to column 2, lines 41-44 and FIG. 1 of Rabe (reproduced below for the Examiner’s convenience) to demonstrate Rabe teaches “the area sealed in the past by a collar or between bellows between the shaft 6 and a peripheral groove 2.01 provided in the upper area 2.0 of the ball joint housing 2 is surrounded by an elastic jacket 21,” (emphasis added). Thus, as may be seen, Rabe actually **teaches away** from an inner cavity with “a circumference smaller than a circumference of an interconnecting shaft.” Indeed, Rabe actually teaches the “elastic jacket 21 which consists of cross-linked or uncrosslinked elastomer, which fills the entire cavity . . . is molded on,” (*see column 2, lines 44-46*). Thus, the ball joint housing 2 does not include “an interconnecting shaft including a first circumference,” and “said second circumference defined by said inner wall, said second circumference being smaller than said first circumference of said interconnecting shaft so as to provide an interference fit,” but rather “an elastic jacket 21” that is molded on to the shaft 6. Accordingly, Rabe teaches away from Applicant’s claimed invention, as defined by independent claims 1, 8 and 15, Rabe does not teach every recitation of independent claims 1, 8 and 15, as required by *Verdegaal Bros.*

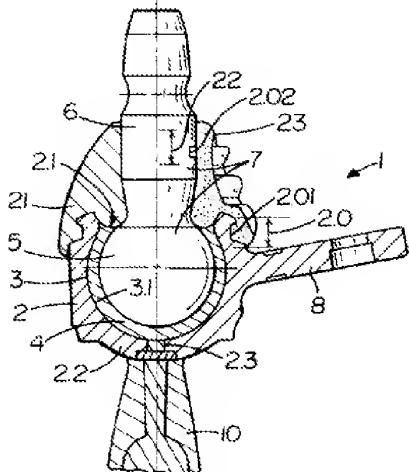


FIG. 1 of Rabe

Claim Rejections Under 35 U.S.C. §103

1. The Law

"To establish prima facie obviousness of a claimed invention, all the claim recitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j).

2. Rabe (DE 296 17 276) (U.S. 6,152,641)

Claims 6, 7, 13, 14, 20 and 21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Rabe. Applicants respectfully traverse the rejection.

Claims 6, 7, 13, 14, 20 and 21 depend from independent claims 1, 8 and 15. The remarks presented above with respect to the §102 rejection are equally applicable here. Specifically, the inadequacy of Rabe to teach every element of independent claims 1, 8 and 15 by not teaching "an interconnecting shaft including a first circumference," and "said second circumference defined by said inner wall, said second circumference being smaller than said first circumference of said interconnecting shaft so as to provide an interference fit," is also fatal to the Examiner's §103 rejection. Additionally, the knowledge of one of ordinary skill in the art does not make up for the

inadequacy described above in Rabe. Therefore, the combination of the knowledge of one of ordinary skill in the art and Rabe does not teach every recitation of claims 6, 7, 13, 14, 20 and 21, as required in *In re Royka*.

3. Blee (U.S. 5,379,856) and Ayers (U.S. 4,500,151)

Claims 6, 7, 13, 14, 20 and 21 were rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Blee and Ayers for the same reasons noted in Rabe. Applicants respectfully traverse the rejection.

Claims 6, 7, 13, 14, 20 and 21 depend from independent claims 1, 8 and 15. The remarks presented above with respect to the §102 rejection are equally applicable here. Specifically, the inadequacy of both Blee and Ayers to teach every element of independent claims 1, 8 and 15 by not teaching “an interconnecting shaft including a first circumference,” and “said second circumference defined by said inner wall, said second circumference being smaller than said first circumference of said interconnecting shaft so as to provide an interference fit,” is also fatal to the Examiner’s §103 rejection. Additionally, the knowledge of one of ordinary skill in the art does not make up for the inadequacy described above in Blee and Ayers. Therefore, the combination of the knowledge of one of ordinary skill in the art and any of Blee and Ayers does not teach every recitation of claims 6, 7, 13, 14, 20 and 21, as required in *In re Royka*.

4. Rabe (DE 296 17 276)(U.S. 6,152,641), Blee (U.S. 5,379,856), Ayers (4,500,151) in view of Goldowsky (U.S. 3,911,203)

Claim 22 was rejected under 35 U.S.C. 103(a) as being unpatentable over anyone of Rabe, Blee and Ayers in view of Goldowsky (U.S. Patent No. 3,911,203). Applicants respectfully traverse the rejections.

Claim 22 depends from independent claim 15. The remarks presented above with respect to the §102 rejection are equally applicable here. Specifically, the inadequacy of Rabe, Blee and Ayers to teach every element of independent claim 15 by not teaching “an interconnecting shaft including a first circumference,” and “said second circumference defined by said inner wall, said

Application No. 09/755,798
Amdt. dated November 16, 2007
Reply to Office action of September 17, 2007

second circumference being smaller than said first circumference of said interconnecting shaft so as to provide an interference fit,” is also fatal to the Examiner’s §103 rejection. Additionally, Goldowsky does not make up for the inadequacy described above in Rabe, Blee and Ayers. Therefore, the combination of Goldowsky and any of Rabe, Blee and Ayers does not teach every recitation of claim 22, as required in *In re Royka*.

Examiner’s Response to the Arguments

The Examiner states Applicants’ arguments filed on August 28, 2007 have been fully considered but they are not persuasive (see Office action, page 5). The Examiner proceeds to states that the Applicants have failed to claim the interconnecting shaft with a circumference that is greater than that of the inner cavity of the boot. In response to the Examiner’s arguments, each of independent claims 1, 8 and 15 have been amended to more clearly claim the interconnecting shaft. More specifically, claims 1, 8 and 15 have been amended to each recite “an interconnecting shaft including a first circumference.” Therefore, Applicants believe they have positively claimed the interconnecting shaft in each of the independent claims. Accordingly, withdrawal of the following rejections under 35 U.S.C §§ 102 and 103 are respectfully requested.

Application No. 09/755,798
Amdt. dated November 16, 2007
Reply to Office action of September 17, 2007

CONCLUSION

In view of the above amendment, Applicants believe the pending application is in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 07-1360, under Order No. G00284/US from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. § 1.136 is hereby made, the fee for which should be charged to such deposit account number.

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Respectfully submitted,



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